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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/755,849
Filing Date: January 12, 2004
Appellant(s): BAIN, WALTER M.

MAILED

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GROUP 3600

Randall B. Bateman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/2/06 appealing from the Office action
mailed 3/6/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|--------|
| 5,385,265 | Schlamp | 1-1995 |
| 5,597,995 | Williams et al | 1-1997 |

5,713,485

Liff et al

2-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 5 and 6, it is unclear what is meant by the phrase "and storing electronically via control portion information regarding the filled prescriptions."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 60-67, 69-76, 78-85, 87, 88-92, 94-102, 104-106, 109 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265).

As described in Claims 60, 61, 69, 70, 75, 81, 95, 101, Williams discloses a semi-automated pharmacy for filling prescriptions for customers with a will call area (380) (see col. 10, lines 48-53) in which finished prescriptions are kept for customers.

Williams further discloses filling a prescription by placing information unique to a single patient on a container of medication, as illustrated in figure 2, third step. Williams further discloses a semi-automated pharmacy for filling prescriptions for customers with a will call area (380) (see col. 10, lines 48-53) in which finished prescriptions are kept for customers. Williams discloses a computer (104) for inputting customer data and prescription data.

Further **regarding Claims 67, 71, 76, 92, 96 and 101**, Williams discloses payment at col. 1, lines 9-15, 26-29, col. 4, lines 7-9 and col. 10, lines 57-62.

Further **regarding Claims 69 and 101**, note that Williams discloses transmitting the prescription from a host computer (104) to a checking work station (300), in which a pharmacist checks the prescription that is filled. See Williams, col. 3, lines 10-64. This is construed as transmitting the prescription to the pharmacist.

Further **regarding Claims 82, 83, 95 and 110**, note that Williams discloses scanning information about the filled prescription at figure 2, fourth step.

As described in Claims 60-65, 69, 70, 72 73, 75, 78-85, 87, 88, 90, 95, 97-106
Williams does not expressly disclose, but Schlamp discloses a dispenser placed in a wall, for holding items such as filled prescriptions, for customers with access to a particular bin through doors (4') by the customers on one side of the wall and access to a particular bin by the pharmacist to load a customer's prescription on the other side of the wall, through doors (40'). Schlamp further discloses loading the filled prescriptions in a first side of the dispenser, storing information associated with the single patient sufficient to identify the single patient electronically in the controller (one piece of

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information), storing the location of the filled prescription within the dispenser via the control portion, associating the location of the filled prescription with the information associated with the single patient in the controller, providing access to the second side of the dispenser so as to allow a customer to input information associated with the single patient into the controller, and dispensing the prescription to the customer once the information associated with the single patient has been entered. See Schlamp, figures 1 and 2 and col. 1, line 55-col. 2 line 46 and col. 6, lines 29-60.

Regarding Claims 91, 101 and 109, note that Schlamp's compartments (23) are considered to be functionally equivalent to a container. Note that Merriam-Webster's Collegiate Dictionary, 10th edition, p.1267, defines the word "trough" in entry 1b as "any of various domestic or industrial containers."

Further **regarding Claims 101 and 109**, note that moving the prescription from the receiving structure and dropping said prescription into a dispensing trough separate from the receiving structure is construed to be equivalent to the customer removing the prescription from Schlamp's compartment (23) and placing it on shelf (5, 5'), described at col. 4, lines 2 and 3. Also note that gripper (22, 22') can also be construed as a trough separate from the receiving device. Schlamp also discloses at col. 4, lines 15-23, that any conceivable device able to transport items or compartments is envisioned as being used with Schlamp's dispenser.

Both Williams and Schlamp are considered analogous art because they both concern article handling, and in particular, Williams concerns filling and storing prescriptions for customers while Schlamp discloses holding finished items for

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customers. See Schlamp, figures 1 and 2 and col. 1, line 55-col. 2 line 46 and col. 6, lines 29-60.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Schlamp's "will call" device to Williams pharmacy, said device allowing the loading of finished prescriptions into a merchant side of the system and allowing customer pickup of the finished prescription on the other side of the "will call" device, the "will call" device located in a wall between the secure pharmacy prescription filling area and an unsecure customer pickup area on the other side of a wall.

As suggested by Schlamp, one ordinarily skilled would have been motivated to use Schlamp's device in Williams' pharmacy to reduce storage area, reduce the distance required by the pharmacist to reach system, to secure the filled prescriptions while allowing access by customers to their prescriptions after hours, and to provide for cooling/refrigeration of the unit. See Schlamp, col. 2, lines 4-44.

Further **regarding Claims 70 and 83**, note that it would have been obvious to scan information to determine the location of the filled prescription within the automated prescription dispensing system in light of Schlamp's disclosure of storing the location of the filled prescription within the dispenser at col. 6, lines 29-32.

Further **regarding Claim 74**, it would have been obvious to allow customers to use Williams' dispenser after hours since the purpose of using such a dispensing device

as taught by Schlamp is to save the cost and time of staffing the pharmacy continuously. See also Williams, col. 2, lines 32-38.

Further **regarding Claim 66**, note that Williams discloses counseling the customer at col. 8, lines 42-50.

Further **regarding Claims 81 and 107**, note that Williams discloses at figure 2, step 2, the entry of medical prescription and customer information to the host computer. Williams at col. 2, lines 10-14 describes entering the patient's name, physician's name, and other vital data the pharmacist may need. Note that it is considered obvious that such vital data such as a phone number, social security number, medicare number, insurance number, or any other item would be required to meet federal and state regulations and/or to reasonably insure proper identification of both the patient and the prescription and verification thereof. Williams further discloses at col. 5, lines 52-60, the use of patient name, prescription number, name of drug product, name of doctor and NDC code number. Williams at col. 8, lines 43-50 discloses that the customer provides personal information required by the pharmacy staff, of which such personal information can be construed to include phone numbers, addresses, social security numbers, or any other piece of information reasonably calculated to identify the patient and connect him/her to the prescription being processed.

Further **regarding Claims 81 and 107**, Schlamp discloses that his dispensing apparatus requires the customer to enter an identifying code, which can include the

account number and the customer number. These two items can be construed as being both required and both making up the identifying code, or in the alternative, it would have been obvious to include both pieces of information to verify the customer's identity and connection to the items to be dispensed.

One ordinarily skilled in the art would have considered both Williams' and Schlamp's teachings regarding entering multiple pieces of information to have been mutually instructive to thereby require a customer to include several pieces of information, such as name, address, telephone number, prescription, NDC number, or other appropriate information for input into the vending machine so as to facilitate identification and verification of the customer identification and the connection to the items being dispensed.

Williams does not expressly disclose, but Liff discloses a communication system connecting each dispenser with a host computer (100), which allows for patient (190) follow up. See col. 10, lines 7-12. Liff further discloses communication between the system and the dispenser at col. 1, lines 1-4, col. 2, lines 25-30, col. 5, lines 25-40, col. 6, lines 1-3 and 48-59, col. 7, lines 12-40, col. 8, lines 35-40 and col. 9, lines 1-5.

At the time of the invention, it would have been obvious to one of ordinary skill to have enabled Williams' dispenser to allow communication between the patient/customer and the pharmacist or doctor through the dispenser, for the purpose of patient follow up or patient counseling, since Liff discloses counseling the patient by communication

through the dispenser itself and Williams discloses counseling the customer. See Liff, col. 10, lines 7-15 and Williams at col. 8, lines 42-50.

Regarding Claim 89, note that it would have been obvious to include multiple prescriptions in a single compartment, since one ordinarily skilled would have recognized this as an efficient method of saving space and providing the customer with his order.

Regarding Claim 94, note that it would have been obvious to one of ordinary skill in the art to remove items which have not been dispensed for a particular period of time, since such an event is indicative of an anomaly with the prescription order, and because otherwise, the limited number of compartments in the dispenser would be rendered unusable if too many unclaimed orders were left in compartments indefinitely. Also, drugs often have expiration dates, which would render them unusable if not picked up within a certain time period.

6. Claims 68, 77, 86, 93, 103, 107, 108, 111 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265) and further in view of Liff et al (US 5,713,485).

Williams discloses the system described above.

Regarding Claims 103, 107, 108, 111 Williams does not expressly disclose, but Liff discloses using sensors (36) to determine the location of packages of pharmaceuticals in a particular bin. See Liff at col. 2, lines 46-49 and col. 5, lines 7-14.

Regarding claims 68, 77, 93 and 112, Williams does not expressly disclose, but Liff discloses billing a third party insurance provider for the prescription. See Liff at col. 4, lines 35, 36 and col. 9, lines 12-19.

Both Liff and Williams are considered analogous art because they both concern pharmaceutical delivery systems.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have charged a third-party healthcare provider in Williams' pharmacy, as taught by Liff.

The suggestion/motivation would have been to allow customers to pay for prescriptions through standard well-known third-party insurance providers.

Regarding Claim 86, it would have been obvious to use sensors to detect prescriptions in each of William's bins, as taught by Liff.

The suggestion/motivation would have been to detect jammed bins as well as to monitor inventory. See Liff at col. 4, lines 35, 36 and col. 9, lines 12-19.

(10) Response to Argument

A. The Examiner's rejection of claims 60-80, 93 and 95-112 is proper.

The Appellant states that the final office action does not make out a prima facie case of obviousness because it doesn't specifically identify where in the prior art all the limitations in the claims are located. In response, the Examiner notes that the rejection complies with rule 1.104(c)(2), which states:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as *practicable*. The pertinence of each reference, *if not apparent*, must be clearly explained and each rejected claim specified. Emphasis provided.

It is the belief of the Examiner that the prior art has been detailed and cited, "as nearly as practicable", with citations to Williams, Schlamp and Liff which, from reading them, make readily apparent what elements of the claims are found where in the prior art.

1. Appellant's claims read on the prior art, Williams, Schlamp and Liff, which support a prima facie case of obviousness.

Appellant's arguments filed 11/2/06 have been fully considered but they are not persuasive. Regarding Appellants' arguments concerning the rejection of Williams in view of Schlamp, **found in Appellant's brief at p.16-22**, Appellant asserts that Schlamp and Williams are not combinable and could only be arrived at through hindsight. Appellant also asserts that Schlamp, Williams and Liff teach away from being combined as described above.

However, the art speaks for itself. In relation to Appellant's broadly written claims, Schlamp specifically teaches holding a merchant's finished items for customers in Schlamp's bins. Williams teaches a pharmacy production area in which pharmacists

fill and produce prescriptions for customers and place them in a "will call" area. Such filled prescriptions are considered to be "items" as one ordinarily skilled would have considered this term to mean. It would have been obvious, based on Schlamp's teaching as cited above at col. 2, lines 4-44, which explicitly states that Schlamp's vending device is installed such that one bin door is located facing the merchant and the other bin door on the opposite side faces the customer, much like a cooled dairy freezer in a supermarket, in which the merchant loads the milk from the inside, and the customer opens the door from the opposite side to remove the milk. Williams also discloses at col. 2, lines 62-64, that the objective of Williams' system is to provide an "efficient, automated, fast, economical and effective pharmacy system", of which Schlamp's apparatus furthers this goal. Therefore, there is suggestion for one ordinarily skilled in the art to use Schlamp's vending apparatus in place of the William's will call area.

Further note that Williams discloses using a label with a barcode on drug vials and verifies such information with a checking station. See Williams, abstract. Williams also discloses the "requiring of multiple pieces of information associated with a patient and verifying at least one of patient information and prescription information with the person prior to filling the prescription", as is found in several of the claims, including Claim 81. See, for example, Williams, figure 2. Schlamp discloses a vending machine with access from a merchant side and access by a customer on an opposing side. There are several reasons, described above, for using such a dispenser with access from both sides. One is to reduce the amount of time a merchant has to spend

restocking the vending machine. The other is to keep one side of the machine, the restocking side, in a secure environment. This is suggested again, by Schlamp, for example, at col. 2, lines 14-35. Use specifically with a prescription is not necessary for providing motivation to use Schlamp in combination with Williams since these citations provide such motivation.

2. The combination of Williams, Schlamp and Liff is supported.

Further, concerning other claims rejected in using Liff, this piece of prior art discloses using sensors at each bin to detect and monitor inventory. Liff also discloses an information network of various dispensers with different configurations. It is intended that Liff's system be used with various dispensers, such as Schlamp's. Appellant's claims do not provide limitations that preclude use of Schlamp, Williams or Liff. Therefore, it would have been obvious to combine Schlamp, Williams and Liff to obtain Appellant's apparatus and method as claimed.

3. Williams, Schlamp and Liff are supported and teach all of Appellant's claim elements.

In addition to the arguments presented previously, one is directed to the Examiner's final rejection, recited above, which outlines all Appellant's claim elements and where they are found in the prior art.

4. The Claims rejected under Williams, Schlamp and Liff are not patentable.

With regards to Appellant's arguments concerning Claim 60, found in **Appellant's brief at p.23**, again note that Williams teaches a pharmacy which handles prescriptions and places them in a will-call area. Schlamp teaches a vending device

which automates a will-call area, thereby solving a problem found in Williams system. Therefore, one ordinarily skilled in the art would have found it obvious to obtain Appellant's Claim 60 with the combination of Williams with Schlamp's teaching of using an automated will-call machine. See again, section 5 under the grounds of rejection, cited above. The rest of the claims, Claims 61-112 are similarly delineated above in sections 5 and 6 above.

It is believed that the arguments regarding each individual claim put forth by the **Appellant at p.23-33 of the brief** are answered in sections 5 and 6 of the final rejection delineated above. Williams, Schlamp and Liff read on Appellant's claims as described in those sections above. Appellant has been on notice of these pieces of prior art during at least the last two office actions.

B The claims rejected under Williams in view of Schamp are not patentable.

See arguments regarding argument A(4) immediately preceding this section;

and

C. The secondary indicia is not dispositive in light of the overwhelming evidence presented by Williams, Schlamp and Liff, which read on Appellant's claims, as discussed above.

Appellant also discusses secondary indicia of obviousness in Appellant's brief at pages 34-37. This indicia includes evidence of commercial success, fulfilling a long-felt need, and the failure of others to solve the problem as well as copying.

Regarding Appellant's declaration of 12/16/05, it is presumed that this is a 1.132 affidavit, despite that there is no designation as such.

Appellant states at p.35, lines 17-19 of the brief, after mentioning a litany of prior art references, that "none of this art, however, teaches using a machine to receive and then dispense a filled prescription." Appellant goes on to state "[t]hus, it is clear from the volume of patents attempting to improve prescription filling and delivery that there is a long-felt need."

Nonetheless, Appellant has neglected to mention the pivotal Schlamp reference cited above, which clearly discloses and teaches using a dispensing device specifically to replace a manual will-call area in any retail establishment, of which a pharmacy is considered such a retail store. One ordinarily skilled would have found that Williams provides the motivation to dispense a specific item, a drug prescription, to a customer using Schlamp's device in place of William's will-call area.

Despite all of the cited references and applications filed by others in this area and television interviews and reports on Appellant's apparatus, such considerations of evidence of commercial success, fulfilling a long-felt need, the failure of others to solve the problem and copying are considered to be *secondary* to the prior art which specifically discloses, teaches and suggests Appellant's apparatus, as described in Appellant's claims.

Per MPEP 716.06, evidence of nothing more than mere copying is not dispositive since such copying may be motivated for various reasons, such as disregard for the patent system. It is not the task of the Patent Office to determine such infringement

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issues, which are the realm of the federal court system. Instead, it is only for the Patent Office to determine patentability of the Claims presented before the Examiner.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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